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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/903,388	07/09/2001	Dean Furbush	09857-061001	9349
26161 7590 12/23/2010 FISH & RICHARDSON P.C. (BO) P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			EXAMINER SUBRAMANIAN, NARAYANSWAMY	
			ART UNIT	PAPER NUMBER
			3695	
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Please find below and/or attached an Office communication concerning this application or proceeding.

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DEC 22 2010

Fish & Richardson P.C.
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In re Application of	:	DECISION ON THE PETITION
Dean Furbush et al.	:	UNDER 37 CFR 1.144 TO
Application No. 09/903,388	:	WITHDRAW REQUIREMENT
Filed: July 9, 2001	:	FOR RESTRICTION
For: ORDER PROCESSING FOR AUTOMATED		
MARKET SYSTEM		

Applicant's petition under 37 CFR 1.144, filed December 1, 2010, requests a review and withdrawal of the Requirement for Restriction mailed November 30, 2009, and supplemented on January 4, 2010.

The petition is **GRANTED**.

A review of the file record indicates that the examiner required restriction between Group I, claims 1-17, 34-39 and Group II, claims 29-33, 40-49 on November 30, 2009, with a correction made to the restriction on January 4, 2010. The examiner felt that the above groups were subcombinations usable together in a single combination. On December 29, 2009 the applicant submitted an election of Group I, with traverse.

The examiner's restriction indicated that Group I had a separate utility of "choosing through the graphical user interface rendered on the display a priority type for how the order interacts with contra side quotes/orders in the trading venue". The examiner also indicated that Group II had a separate utility of "executing the order against the contra-side interest according to a determined priority type". The examiner indicated that the inventions of the two groups were distinct based upon the above noted utilities. Although not specifically recited in the restriction, the examiner indicated in the Office action of July 1, 2010, that there would be a serious burden on the examiner because the inventions of the two groups "require different search strategies and search terms" and that "...the prior art applicable to one invention would not likely be applicable to another invention".

The requirement for a proper restriction for subcombinations usable together is when the subcombinations are distinct by not overlapping in scope, are not obvious variants of each other, and if it is shown that at least one subcombination is separately usable. Furthermore, such a restriction would only be proper if there would be a serious search an examination burden if restriction were not required.

In this case, the separate utilities indicated by the examiner are actually not unique to the other group, nor can it be said that the groups do not overlap in scope. Group I includes claims that

execute orders "against the contra-side interest according to a determined priority type" as evidenced by claims 37-39. Group II includes claims that include "a graphical user interface rendered on the display which allows a user to choose a priority type for how the order interacts with contra side quotes/orders in the trading venue" as evidenced by claim 33. Furthermore, given the substantially identical limitations of the alleged separate utilities, it is also not seen how one can draw a conclusion that the examiner would be required to search using "different search strategies and search terms" and that "...the prior art applicable to one invention would not likely be applicable to another invention".

It is not seen that the explanation provided by the examiner for the restriction requirement made on November 30, 2009 can be deemed to be a proper justification for requiring restriction.

As a result, the above-noted requirement for restriction mailed November 30, 2009 is hereby **WITHDRAWN**.

The petition for withdrawal of the restriction requirement is **GRANTED**. Claims 1-17 and 29-49 (all remaining claims in the application) are reinstated to pending status. The application is being returned to the examiner of record for an Office action in view of the response dated December 1, 2010, consistent with this decision.

Any questions or comments with respect to this decision should be forwarded to Quality Assurance Specialist Steven N. Meyers at (571) 272-6611.

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snm/snm: 12/20/10

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